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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/701,199

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Dennis A. Durbin

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01/10/2006

Michael F. Williams

Simmons, Perrine, Albright & Ellwood, P.L.C.

Suite 1200

115 Third Street SE

Cedar Rapids, IA 52401

EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/701,199	Applicant(s) DURBIN, DENNIS A.	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/21/05 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in
5 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is
eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)
has been timely paid, the finality of the previous Office action has been withdrawn pursuant to
37 CFR 1.114. Applicant's submission filed on October 21, 2005 has been entered.

Response

10 2. Receipt is acknowledged of the response filed on October 21, 2005. No claims were
amended, canceled, or newly added. Currently, claims 1-34 remain in the examination.

Claim Rejections - 35 USC § 102

15 3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
20 sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 9-13, 15-21, 23-29, and 31-34 are rejected under 35 U.S.C. 102(b) as being
anticipated by Wang et al. (US 5,513,264, previously cited, hereinafter “Wang”).

Re claims 1, 2, 5, 6, 10-13, 15, 18, 23-26, 29, 31, and 34, Wang discloses an one-
25 dimensional /two-dimensional barcode reader (see abstract; col. 4, lines 12-23) comprising a

hand-held housing (see figures 3a and 3b; col. 5, lines 8+), a photo sensor array in the form of CCD (col. 5, lines 10+); an optical system the form of CCD (col. 5, lines 10+); an optical system (col. 1, lines 11+); a memory system for storing the captured image (col. 6, lines 2+) and a display system 16 (col. 4, lines 23+) which displays the actual code being scanned.

5 Re claims 3, 19, and 28, as disclosed in the abstract, the dataform can be edited or modified, which can be considered as a feedback.

Re claim 9, 17, and 33, the reader allows users to focus on area or field of depth (col. 4, line 67 – col. 5, line 3).

Re claims 4, 20, and 27, the reader itself contains function of pattern recognition (since
10 some codes are not decoded even if they are aimed and captured).

Re claim 21, the “neural” is defined as “1: of, relating to, or affecting a nerve or the nervous system 2: situated in the region of or on the same side of the body as the brain and spinal cord:” (Merriam-Webster’s Collegiate Dictionary, 10th edition). The encoding system 10 includes various I/O devices and a computer. Analogously interpreted, the barcode reader
15 contains a processor which is connected to subcomponents such as image capturing and processing, decoding, A/D converting, etc. In view of the above, pattern recognition system is part of the network within the device.

Claim Rejections - 35 USC § 103

20 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 16, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over

5 Wang et al. (US 5,513,264) in view of Sant' Anselmo et al. (US 5,331,176, previously cited, hereinafter "Sant' Anselmo"). The teachings of Wang have been discussed above.

Wang fails to specifically teach or fairly suggest that the reader apparatus is further comprised of a zoom system.

Sant' Anselmo teaches a raster optical scanner (see abstract; col. 4, lines 23-34)

10 comprising a zoom system (col. 4, lines 55+).

In view of Sant' Anselmo's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further incorporate a well-known zoom system to the teachings of Wang to in order to enlarge the target and therefore improve image capturing and decoding. Use of zooming system in an optical device such as camera and scanner is well
15 within one ordinary skill in the art. Use of zoom to improve overall readability of the barcode is an obvious expedient one ordinary skill in the art would contemplate.

7. Claims 14, 22, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (US 5,513,264) in view of Dvorkis et al. (US 5,373,148, previously cited, hereinafter "Dvorkis"). The teachings of Wang have been discussed above.

20 Wang fails to specifically teach or fairly suggest that the reader apparatus is further comprised of a rastering device. Wang also does not disclose that the reader has a means to reduce jittering when in use.

Dvorkis teaches a raster optical scanner (see col. 3, lines 21-40) further comprising a means to eliminates jittering of the devices (col. 12, lines 13-24).

It is the Examiners' view that raster scanning method, and jitter reducing means as discloses in Dvorkis are well known improvements found in optical readers. Therefore, such modifications would have been an obvious extension as taught by Dvorkis for improving overall functionalities of the scanner and therefore an obvious expedient.

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Response to Remarks

8. Applicant's remarks filed on October 21, 2005 have been carefully reviewed and considered.

In remarks, Applicant essentially argues that that patent to Wang, Sant' Anselmo, and Dvorkis are invalid references since the instant application's effective date is that of 07/849,771, which was filed on March 12, 1992. Applicant states, "Applicant believes, however, that the pending application is entitled to the March 12, 1992 filing date and the cited references do not anticipate the pending application. Although the filing date of the pending application may be after the termination date of 07/849,771 application, MPEP 201.08 states that an application may claim the benefit of an application similarly entitled to the benefit of the filing date of the first application." Examiner respectfully requests the Applicant to cite the section of MPEP 201.08 indicating such ground.

In fact, Examiner's reading of MPEP 201 provides rather concrete guidelines for filing Continuation-in-part application.

20 MPEP 201.08 provides a guideline for **continuation-in-part application** as follows:

Accordingly, an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of an earlier nonprovisional application if the alleged continuation-in-part application complies with the **following formal requirements of 35 U.S.C. 120:**

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(A) The first application and the alleged continuation-in-part application were filed with at least one common inventor; (B) The alleged continuation-in-part application was “filed before the patenting or abandonment of or termination of proceedings on the first application or an application similarly entitled to the benefit of the filing date of the first application”; and (C) The alleged continuation-in-part application “contains or is amended to contain a specific reference to the earlier filed application.” (The specific reference may be in an application data sheet. See 37 CFR 1.76.)

Even the first link between the instant application and the immediate parent 09/961,697 (US Patent 6,641,046) is improper. MPEP 201.07 states regarding **continuation application**:

At any time before the patenting or abandonment of or termination of proceedings on his or her earlier nonprovisional application, an applicant may have recourse to filing a continuation in order to introduce into the application a new set of claims and to establish a right to further examination by the primary examiner. A continued prosecution under 37 CFR 1.53(d), however, must be filed prior to payment of the issue fee unless a petition under 37 CFR 1.313(c) is granted in the prior application. In addition, a continuation or divisional application may only be filed under 37 CFR 1.53(d) if the prior nonprovisional application is a design application that is complete as defined by 37 CFR 1.51(b).

The issue fee for 09/961,697 was paid on August 19, 2003, and the instant application was filed on November 04, 2003.

At least on above grounds, applicant’s claiming effective filing date back to the filing date of 07/849,771 is improper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

5 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and*
10 *Trademark on February 25, 1997 at 1195 OG 89.*

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
15 application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

20 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Primary Examiner
Art Unit 2876
December 29, 2005

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